

### **III. REMARKS**

Claims 1, 2, 5,7,8,12, 15,16,25, 27, and 28 are amended to clarify what is intended to be protected in this application. Claims 4,14,26, and 29 are cancelled. No new matter is presented. Claims 1-3, 5-13, 15-25, 27-28 are presented for further consideration. Applicant has considered the Examiner's comments set forth in the Office Action mailed July 2, 2008 and responds in detail below. Reconsideration of the application is respectfully requested in view of the following remarks.

Applicant has amended the claims for consistency and to further emphasize the distinguishing features of the claimed subject matter. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. Applicant submits that such amendments are properly entered under 37USC1.116 and accordingly, Examiner is requested to enter these amendments.

The Examiner has rejected the prior arguments of Applicant and maintained the rejections previously presented. No new art is cited.

Claims 1,2,12, 17, 18, 21, 25 and 28 stand rejected under 35USC103(a) on the basis of the combined teaching of the cited reference Gorsuch, U.S. Patent No. 6,526,034 in view of the reference Sinton, et al, U.S. Patent No. RE38,787. This rejection is traversed on the following grounds:

The combined teaching of Gorsuch and Sinton does not render claims 1, 2, 12, 17, 18, 21, 25 and 28 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.**

In particular the combined teaching fails to disclose or suggest the following features of independent claim 1:

**“transmitting a message from the first network to the mobile station in response to the data transmission service not being providable substantially in accordance with the service request and/or the terminal not being reachable via the first network; and the service request is transmitted from the mobile station to the second network in response to said message received from the first network; and**

**transmitting a second service request from the mobile station to a second network in response to in response to said message received from the first network..”**

Independent claims , 12, 18, 21, 25, and new claim 28 contain equivalent language.

Applicant has combined the limitations of claim 4 with claim 1, claim 14 with claim 12, claim 26 with claim 25 and claim 29 into claim 28. On the basis of this amendment, the above rejection is rendered moot.

Nevertheless, since the combined teaching of Gorsuch and Sainton remain as the primary reference in the majority of further rejections, Applicant submits the following remarks. The Examiner acknowledges that reference Gorsuch fails to disclose or suggest the transmission of a second service request from the mobile station to a second network. To remedy this deficiency in the teaching of Gorsuch, the Examiner cites the teaching of Sainton.

Gorsuch describes a system in which there are two wireless communication paths, one low cost, for example a LAN, and one relatively higher cost, for example, a cellular network. A local wireless transceiver has the capability of communicating with one or

the other, or both. A selection process is established, according to which, the connection is established with the LAN if it is available, i.e. within range, or with the cellular system if the LAN is not available. The connection decision is based solely on the availability of the connections. (see column 3, lines 28-65).

As described in independent claim 1, the decision in the subject application may involve multiple connection paths involving several networks. A first network responds to a service request to a terminal by checking availability of the terminal and the nature of the service request. The requesting mobile station receives a message from the first network indicating that the service or destination terminal is not available as requested. If the message from the first network is received, then a second service request is sent to a second network. The process assumes that multiple networks may be accessed.

The system of Gorshuch never gets to consider the content of the service request since the connection is determined before a request is fully received. Accordingly there is no opportunity for checking the content, transmitting a response and sending a second request. In Gorsuch, the availability of a path is checked, selected, and connected. Gorsuch therefore, fails to describe or suggest the above features of claim 1. Similar language is contained in the other independent claims 1, 12, 18, 21, 25, and 28

The Examiner seeks to remedy the above deficiencies of Gorsuch by combining its disclosure with that of Sainton. The Examiner refers to figure 6b of the reference Sainton and also to claim 42. Figure 6b in particular involves a choice between a cordless land line system and a cellular network. The choice is determined by accessibility of the cordless land line system, if the user device is within range of the cordless system, then the cordless system is used. If the user device is out of range of the cordless system, but within range of a cellular system, the cellular system is accessed. There is a provision that allows the user to preprogram a device to indicate calling criteria (col 2, lines 48-61). There is no determination based on the content or destination of a particular service request.

The teaching of Sainton therefore fails to remedy the deficiencies of Gorsuch as indicated above. As a result the combined teaching of Gorsuch and Sainton fails to support the rejection of the independent claims of this application based on obviousness. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims.

Claims 3, 13, and 19 are rejected, under 35USC103(a), based on the combined teaching of Gorsuch and Sainton and further in view of Roberts, U.S. Patent No. 7,181,201. This rejection is traversed on the following grounds:

The combined teaching of Gorsuch, Sainton and Roberts does not render claims 3, 13, and 19 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."**

In particular the combined teaching fails to disclose or suggest the claimed features of amended independent claims 1,12. 18, 21, 25, and 28 for the reasons indicated above. In addition, the Examiner applies the combined teaching of the references Gorsuch and Sainton as indicated above, but further acknowledges that this combined teaching fails to disclose wherein the mobile station checks whether the terminal belongs to the first network and cites the reference Roberts to remedy this deficiency.

The reference Roberts involves a system for routing a call to a called party's landline or wireless communication unit based on the availability of the called party's wireless communication unit. (see abstract) This is similar to the embodiment of Sainton in

which the choice is based on accessibility of the calling party's multi-modal device, however, in Roberts, the selection is based on the accessibility of the called party's wireless device. The teaching of Roberts, therefore fails to remedy the deficiencies of the combined teaching of Gorsuch and Sainton. The system in Roberts automatically routes the call. There is no checking of the first service request and there is no transmitting of a second request by the caller to a second network, if the first service cannot be fulfilled in the first network. The combined teaching of Gorsuch and Sainton in view of Roberts therefore, fails to render claims 3, 13, and 19 obvious. These dependent claims contain all of the limitations of the there related independent claims as indicated above.

Claims 4-9, 14-16, and 20 are rejected under 35USC103(a) based on the combined teaching of Gorsuch and Sainton and further in view of McCanne, U.S. Patent No. 6901445. This rejection is traversed on the following grounds:

The combined teaching of Gorsuch, Sainton and McCanne does not render claims 4-9, 14-16, and 20 obvious because it fails to teach or otherwise suggest each and every limitation of the claims.

In particular the combined teaching fails to disclose or suggest the claimed features of amended independent claims 1, 12, 18, 21, 25, and 28 for the reasons indicated above. In addition, the Examiner applies the combined teaching of the references Gorsuch and Sainton as indicated above, but further acknowledges that this combined teaching fails to disclose **wherein the first or local network sends a message to the mobile station indicating that the data transmission service request cannot be fulfilled in the first network.** To remedy this deficiency the Examiner has cited the reference McCanne.

McCanne describes a network set up by an Internet service provider to facilitate the handling of a service request by the server of the service provider. It does not involve multiple networks, but is contained solely within the Internet. In McCanne a virtual

overlay distribution network is established online consisting of a cluster of service nodes established at internet location by a service provider. These nodes act as alternative gateways to the content of the service provider to avoid overloading the system during excessive traffic. The operation of this is described at column 12, lines 17-22 as follows

**"Under this configuration, a client request 510 from an arbitrary host 512 in the Internet 508 is routed to the nearest ARN 514 using proximity-based anycast routing. The ARN 514 redirects the client (path 516) to a candidate service node 518 (path 520) using the range of techniques described herein."**

The Examiner indicates that, based on McCanne, it would be obvious to modify the combined teaching of Gorsuch and Sainton to include sending a message indicating a service is not available and where a service request should be retransmitted. According to the above, McCanne "redirects" a client request to an alternative gateway node based on capacity of a particular node. McCanne does not relate to a selection of a communication network.

It is not clear, just how a person skilled in the art would apply the disclosure of McCanne in the context of the combined teaching of Gorsuch and Sainton, and further, the Examiner's suggested motivation would have no application to the problem to which the subject application is directed. The context of the disclosure of McCanne is described succinctly at column 6, lines 52-56, as follows:

**"A collection of internal IP routers 110 interconnected with communications links 111 provide connectivity among users within an ISP. Specialized border routers 112 situated at the exchange points forward non-local traffic into and out of the ISP."(emphasis added)**

The disclosure of McCanne therefore, does not remedy the deficiencies of the combined teaching of Gorsuch and Sainton and as a result the combined teaching of Gorsuch, Sainton, and McCanne fails to support the rejection of claims 4-9, 14-16, and 20 based on obviousness.

The Examiner has further rejected claims 21-24, 26 and 27 under 35 USC103(a) on the basis of the combined teaching of the references McCanne in view of Gorsuch. This rejection is traversed on the following grounds:

The combined teaching of McCanne and Gorsuch does not render claims 21-24, 26 and 27 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. In particular the combined teaching fails to disclose or suggest the claimed features of amended independent claims 1, 12, 18, 21, 25, and 28.

McCanne describes a network set up by an Internet service provider to facilitate the handling of a service request by the server of the service provider. It does not involve multiple networks, but is contained solely within the Internet. In McCanne a virtual overlay distribution network is established online consisting of a cluster of service nodes established at internet location by a service provider. These nodes act as alternative gateways to the content of the service provider to avoid overloading the system during excessive traffic. The operation of this is described at column 12, lines 17-22, as set out above. According to the above, McCanne "redirects" a client request to an alternative gateway node based on capacity of a particular node. There are no messages sent back to the client from a first network nor is there a retransmission of the request by the client to a second network. The Examiner acknowledges that the reference Gorsuch fails disclose or suggest this feature.

Further McCanne does not relate to a selection of a communication network. The Examiner acknowledges that McCanne does not specifically disclose networks, but discloses nodes, "which are equivalent by definition". A node is described at **SearchNetworking.com Definitions** as: "In a network, a node is a connection point, either a redistribution point or an end point for data transmissions. Clearly a node is part of a network and not the equivalent thereof.

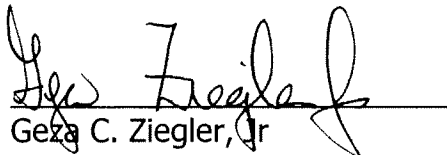
The Examiner in responsive arguments relies on redirection messages from an address that redirects a request to another service node within the same network. This does not involve a selection of a second network.

Accordingly the combined teaching of McCanne and Gorsuch does not support the rejection of claims 21-24, 26 and 27 on the basis of obviousness.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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